REMARKS

Claims 1-7 are pending in the application. By this Amendment, claims 1 and 6 have been amended. Exemplary support for the claim amendments can be found throughout the specification and claims as originally filed. See, for example, page 8, lines 18-28 of the present specification.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

Rejection under 35 U.S.C. § 103

Claims 1-7 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Applicants' description of prior art at paragraphs 8, 9 and 38 of Applicants' own specification in view of U.S. Patent No. 5,470,892 (hereinafter "Gupta") and further in view of either U.S. Patent No. 5,094,520 (hereinafter "Reshef") or U.S. Patent No. 5,648,832 (hereinafter "Houston"). This rejection is respectfully traversed.

The Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

Amended independent claim 1 recites **a method of making a series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**, wherein each ophthalmic lens element is adapted for mounting in eyewear, the ophthalmic lens elements having a non-zero prescription through power, the method comprising the steps of: (i) **molding lens blanks each having a single radius of curvature along a principle meridian of less than 35 mm over a substantial portion of a front surface thereof**; (ii) cutting a back surface on the molded lens blanks, which, together with the front surface, provide the non-zero prescription through power; (iii) edging the lens blanks to provide the **steeply curved ophthalmic lens elements having a maximum hollow depth of at least 8 mm**; and (iv) **repeating steps (i), (ii), and (iii), as required, to obtain the series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**.

Amended independent claim 6 recites **a method of making protective eyewear with a series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**, the method comprising the steps of: (i) **molding the lens blanks each having a front spherical surface with a single radius of curvature along a principle meridian of less than 35 mm over a substantial portion of a said surface** and a molded back surface on the molded lens blank, which, together with

the front surface, provides essentially no through power; (ii) edging the lens blanks to provide the **steeply curved ophthalmic lens elements having a hollow depth of at least 8 mm**; (iii) **repeating steps (i) and (ii), as required, to obtain the series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**; and (iv) mounting the steeply curved ophthalmic lens elements in eyewear so that a center of curvature of the front surface is located approximately on the respective centroids of rotation of the eyes of a wearer in the as worn position.

In contrast, the background art in the present specification discusses steeply curved lenses. (Pages 2-3 of the present specification).

Gupta discloses forming spherical or aspheric lenses. (Col. 1, lines 6-10). Reshef discloses goggle lenses which, the Examiner asserts, have a radius of 24.13 mm and 24.87 mm for inside and outside surfaces, respectively. (Col. 2, lines 57-62). Houston discloses decentered, noncorrective lenses. (Col. 1, lines 3-5).

Applicants respectfully submit that the background art in the present specification, Gupta, Reshef, and Houston, alone or in any combination, fail to disclose or suggest **a series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**, as recited in amended independent claims 1 and 6.

Moreover, Applicants respectfully submit that the ability to use **lens blanks having a single radius of curvature** to provide **a series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**, allows the presently recited processes to be commercially desirable over the cited references. In this regard,

Applicants respectfully submit that Office personnel should consider all rebuttal evidence including secondary considerations such as commercial success when reevaluating any obviousness determination. Graham v. John Deere Co., 383 U.S. 1 at 17, 148 USPQ 459 at 467 (1966).

Further, with regard to the presently recited dimensions including **a radius of curvature along a principle meridian of less than 35 mm** and **a hollow depth of at least 8 mm**, the Examiner's position is that these would have been "obvious design parameters". In this regard, the Examiner's attention is directed to M.P.E.P. § 2144.04 wherein it is provided that the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. See In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Applicants respectfully submit that In re Kuhle did not relate to a steeply curved ophthalmic lens element having a radius of curvature along a principle meridian of less than 35 mm and a hollow depth of at least 8 mm.

Accordingly, it is respectfully submitted that the presently recited radius of curvature along a principle meridian of less than 35 mm and a hollow depth of at least 8 mm, are not mere "design parameters" or "design choices" and are not obvious over the cited references, particularly since the selection of the steeply curved front surface of the lens blank enables the production of an entire series of useful ophthalmic lens elements that can be free of the limitations of the prior art as outlined at page 8 of the present specification.

The Examiner relies upon the assumption that Reshef's FIG. 2 has been drawn to scale and that the hollow depth can be measured merely by looking at the figure in the issued patent in order to meet the presently recited limitation of **a**

hollow depth of at least 8 mm. Applicants disagree with the Examiner's position and respectfully submit that the Examiner must provide reason(s) for assuming that FIG. 2 in Reshef has been drawn to scale. Further, Applicants respectfully submit that even if such an unsupported assumption is made, Reshef still does not disclose or suggest the recited range of **a hollow depth of at least 8 mm**. If the Examiner maintains his position that Reshef indeed discloses the foregoing recited range, Applicants respectfully direct the Examiner's attention to M.P.E.P. § 2142, which provides that the key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s)* why the claimed invention would have been obvious. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (emphasis added). Moreover, it should be noted that if the Examiner is relying on a scientific theory, evidentiary support for his rejection, the existence and meaning of that theory must be provided. In re Grose, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).

Further, Applicants respectfully submit that wraparound lens designs, such as Reshef's goggle lens, are typically non-prescription. (Page 1, lines 27-28 and Page 2, lines 1-2 of the present specification). Goggle lesnses tend to have flat base curves, wrap and sometimes rake, and are achieved by rotating and/or translating the optical axis of the lens in the as-worn orientation. (Page 2, lines 2-5 of the present specification). The line of sight of the wearer however deviates from the optical axis, and the optical performance is significantly degraded and peripheral vision is typically poor. (Page 2, lines 6-8 of the present specification). Accordingly, Applicants respectfully submit that simply rotating the optical axes of the lens in the as worn orientation is not nearly as simple, but instead creates any number of

problems in the fabrication and optical performance of these lenses. (Page 2, lines 3-8) of the present specification). Far from obvious, the present Applicants have designed lenses that the prior art of record clearly indicates to be problematic, and most importantly the applied art fails to disclose or suggest **a series of steeply curved ophthalmic lens elements over a wide range of prescriptions using lens blanks having the same steeply curved front surface**, as recited in amended independent claims 1 and 6.

In view of at least the foregoing, Applicants respectfully submit that the obviousness rejection of claims 1-7 should be withdrawn.

Conclusion

Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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